

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(s): Veijo Vanttinен CONF. NO. 7249
SERIAL NO.: 09/771,052 ART UNIT: 2686
FILING DATE: 1/26/2001 EXAMINER: Mehrpour,
Naghmeh
TITLE: LOCATION OF SUBSCRIBER TERMINAL IN PACKET-
SWITCHED RADIO SYSTEM
ATTORNEY
DOCKET NO.: 324-010115-US (PAR)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

This is in response to the Advisory Action mailed April 12, 2007 and the Office Action mailed November 30, 2006. It is being filed concurrently with a Notice of Appeal. A petition for a two-month extension of time is enclosed herewith.

There are clear errors in facts and procedure in the Final Office Action mailed November 30, 2006 (the "Final Office Action") that make this application ripe for review under the Pre-Appeal Brief Conference review program. The finality of the instant Office Action is based on factual and procedural error and not proper for the following reasons:

- a) A final rejection is not proper when a 35 USC 102(e)/103(a) rejection is properly refuted by reason of common ownership under 35 USC 103(c);

- b) Applicant did not amend the claims in the last response or submit information in an IDS that is now being used by the Examiner; and
- c) There are clear errors in the Office Action mailed November 30, 2006 that require correction and a proper opportunity for Applicant to respond.

1. The finality of the current action is not proper because a statement averring common ownership was filed in reply to the Office Action mailed January 17, 2006. An Office Action **cannot be made "final"** when a statement averring common ownership is made to disqualify a patent in a rejection under 35 U.S.C. §103(a), and the claims are **not** amended. See MPEP §706.02(I)(3) and MPEP §706.07(a).

In the Office Action mailed January 17, 2006, claims 17 and 34 were rejected under 35 U.S.C. 103(a) as being unpatentable over Bull (US Pub No. 2003/0148774) in view of Korpela (U.S. Patent No. 6,311,054) ("Korpela"). The initial statement of rejection on page 7 refers to Korpela, and the body of the rejection also refers to Korpela. The Examiner cites to specific sections of Korpela in the substantive comments, specifically Col. 4, lines 11-17 and 32-36. The citations relate to the Open Systems Interconnection (OSI) and the International Standards Organization (ISO), which are also referenced in the cited sections of Korpela. However, Korpela is commonly owned by the assignee of the instant application.

Thus, in the reply filed on April 7, 2006, Applicant properly averred common ownership of Korpela pursuant to the requirements of 35 U.S.C 103(a). Therefore, Korpela is disqualified as a reference for purposes of U.S.C. §103(a).

Since no claim amendments were made in the reply mailed on April 7, 2006, and a statement averring common ownership was submitted to overcome the rejections, the next action **may not be a final action**. "When applying any 35 U.S.C. 102(e)/103 references against the claims of an application the Examiner should anticipate that a statement averring common ownership at the time the inventors was made may disqualify any patent or application applied in a rejection under U.S.C. 103 based on 35

U.S.C. 102(e). **If such a statement is filed in reply to the 35 U.S.C. 102(e)/103 rejection and the claims are not amended, the examiner may not make the next Office action final if a new rejection is made.” MPEP §706.07(a)**

Therefore, pursuant to MPEP §706.07(a), the finality of the rejection mailed November 30, 2006 is error and must be withdrawn (706.07(c)). A new Office Action with a new response period must be issued (706.07(d)).

2. Furthermore, the present action cannot be a final action because it is not necessitated by an amendment of the claims or on information submitted by Applicant in an IDS. Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p). (See MPEP 706.07(a)). Applicant did not amend any claims in the response filed on April 7, 2006 and the new rejection is not based on an information disclosure statement filed by Applicant. Thus, the current ground of rejection is not necessitated by Applicant's amendment of claims or submission of an information disclosure statement. Thus, this current office action may not be made final.

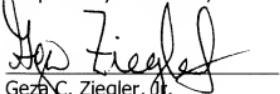
3. Additionally, the Final Office Action mailed November 30, 2006 includes errors that must be corrected before a clear issue can be developed between the Examiner and the Applicant. In the absence of the correction of those errors and the development of a clear issue, the current Office action cannot be and should not be a final action. (See M.P.E.P 706.07). In the Final Office Action the Examiner states that Claims 17 and 34 are rejected under 35 U.S.C. 103(a) over Bull (US 2003/0148774) in view of **Korpela** (US Patent No. 6,311,054). The detailed portion of the Final Office Action is replete with specific citations to Bull and **Korpela**. Now, in the Advisory Action mailed April 12, 2007 (the “Advisory Action”), the Examiner states that the references cited by the Examiner in the rejection of claims 17 and 34 should have been Bull (US 2006/0003775)

and **Boltz** (US Patent No. 6,311,055). The Examiner states in the Advisory Action, there "are typo[s] in the previous office action[.], however, the above information are correct." Yet, if one refers to the Examiner's citations, Col. 4, lines 11-17 and 32-36, one will clearly see that there is no mention of a "layer 3 structure according to the International Standardization Organization (OSI)" as stated by the Examiner. Thus, the Examiner's citations clearly refer to the Korpela patent, and not Boltz, as noted above.

In a telephone interview on April 26, 2007, the Examiner again stated that although the Office Action refers to Korpela, the patent number is to the Boltz reference, and thus the rejection is valid. This is clearly not correct given what is written in the Final Office Action on page 7. Respectfully, Applicant cannot be made to guess as to what the Examiner intended. The Final Office action clearly refers to, and cites Korpela, which is not a proper prior art reference. There is no mention, reference or citation to Boltz. Thus, there are clear factual errors in the Final Office Action that require correction. The "typo[s]" referred to by the Examiner are significant and serious. The Examiner's action is expected to be complete as to all matters. The Examiner clearly refers to Korpela, which is not a prior art reference. Thus, the rejection is not valid. Due to these errors in the Office Action, there is no way for a clear issue to have been developed between the Examiner and the Applicant a new, corrected action is required. (See MPEP 707.06 and 707.07)

Therefore, in view of the foregoing, the finality of the current action is clear error and must be corrected with the issuance of a new, non-final office action.

Respectfully submitted,



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30 April 2007
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CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this correspondence is being deposited transmitted electronically, on the date indicated below, addressed to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Date: 30 April 2007

Signature: Shannon D'Amico
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Person Making Deposit